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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,930

09/07/2006

Michael Vernon Spencer

63669A

4599

109 7590 10/28/2008

The Dow Chemical Company  
Intellectual Property Section  
P.O. Box 1967  
Midland, MI 48641-1967

EXAMINER

NIEBAUER, RONALD T

ART UNIT

PAPER NUMBER

1654

MAIL DATE

DELIVERY MODE

10/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/591,930	<b>Applicant(s)</b> SPENCER, MICHAEL VERNON	
	<b>Examiner</b> RONALD T. NIEBAUER	<b>Art Unit</b> 1654	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 08 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 08 October 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☒ Applicant's reply has overcome the following rejection(s): 103 and double patenting rejections on claim 20.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-5,7,8 and 17-19.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

/Ronald T Niebauer/  
 Examiner, Art Unit 1654

/Anish Gupta/  
 Primary Examiner, Art Unit 1654

Continuation of 11. does NOT place the application in condition for allowance because: Since claim 20 has been cancelled, the previous rejections of claim 20 are withdrawn.

Applicants arguments and amendments have been considered, however they do not place claims 1-5,7,8,17-19 in condition for allowance as applicant has not overcome the outstanding 103 and double patenting rejections of claims 1-5,7,8,17-19 as set forth in previous office actions.

It is noted that claim 8 has been amended. However the amendment is clerical in nature and does not alter the scope of the claims. The arguments below apply to both the 103 and double patenting rejections of claims 1-5,7,8,17-19 as set forth in previous office actions. Applicants argue that the claims reflect a surprising finding and point to page 6 paragraph 2 of the present application. Applicants argue that although no comparisons are necessary that the viscosity drop is very near the theoretically perfect mark. Applicants argue that Savage teach a heat treatment step. Applicants argue that that numerous references teach away from the instant invention. Applicants argue that for similar reasons that the double patenting rejections should not be reapplied.

Although applicants argue that the claims reflect a surprising finding, the burden remains on applicant to establish the results are unexpected and significant (MPEP section 716.02b). Further, the results are to be commensurate in scope with the claimed invention (MPEP section 716.02d). Applicants point to a statement in the specification (last sentence of the page 6 paragraph 2) and to a theoretical comparison. First, the statement in the specification is not necessarily unexpected and significant because such statement is drawn to storage at 4C. Without a real comparison one can not ascertain if the viscosity drop is merely the function of temperature or some other variable such as concentration. Although applicants assert that the 1.5% drop is 'very near' the theoretically perfect mark, there is no basis to state that the drop is 'very near'. Further, it is unclear what method steps were carried out to achieve the results. As such, it is unclear if the results are commensurate in scope with the claimed invention (see MPEP section 716.02d). As such, the applicant has not established that the results are unexpected and significant and there is nothing of record to show that any results are commensurate in scope with the claimed invention.

Although applicants make arguments regarding the heating step of the Savage reference, it is noted that the instant claims are drawn to methods without a neutralization step. Heating or deactivating are not necessarily the equivalent of neutralizing. It is noted that no special definition or direction is provided in the instant application regarding the use of the term 'neutralization step'. Since the instant claims are drawn to 'comprising' language, the claims do not exclude additional steps such as heating. Although applicants make arguments regarding residual peroxides, the instant claims do not exclude residual peroxides. As stated previously, Savage teach the addition of hydrogen peroxide followed by packaging (column 3 line 66-68) with no intermediate neutralization step. Savage specifically teaches that the final product with its viscosity adjusted as required for a particular application can be used or packaged without further treatment (column 3 lines 66-68). Since the viscosity can be adjusted as required the heat treatment is not mandatory as asserted by the applicant. In fact, in run 2-2 (Table 2 column 4) and run 3-2 (Table 3 column 4) Savage teach runs in which there was no heating.

Although applicants argue that certain references teach away, it is noted that the instant rejection (and rejection set forth in the previous office action) is a multiple reference 103 or double patenting rejections. As such, no single reference teaches all of the claimed limitations. In the instant case, the Savage reference is relied upon for the teaching of packaging without a neutralization step.